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without further punishing Chase by awarding [attorneys] fees and costs." We conclude, however, that the district court did not abuse its discretion in the circumstances of this case.

A court may award costs and "may also award a reasonable attorney's fee to the prevailing party as part of the costs." 17 U.S.C. § 505. Chase is correct in noting that such awards are not to be made as a matter of course but, rather, as a matter of the court's discretion. See *Fogerty v. Fantasy, Inc.*, 114 S. Ct. 1023, 1033 [29 USPQ2d 1881] (1994). In exercising such discretion, we have instructed district courts to consider: (1) the motivation of the parties; (2) the objective reasonableness of the legal and factual positions advanced; (3) the need in particular circumstances to advance considerations of compensation and deterrence; and (4) any other relevant factor presented. See *Rosciszewski v. Arete Assoc., Inc.*, 1 F.3d 225, 234 [27 USPQ2d 1678] (4th Cir. 1993).

[4] Chase maintains that he had a reasonable basis to test the legal question of whether animal mannequins are copyrightable and thus he should not be assessed legal fees for doing so. He points to the district court's assessment that the case "presented legal questions that were novel and complex." We agree that if Chase had pursued these legal issues in good faith, an award of attorneys fees would constitute an abuse of discretion. But the record in this case belies the suggestion that Chase maintained his legal position in good faith.

The record shows that Chase adopted a business practice of copying animal mannequins created by competitors, justifying the practice with the claim that animal mannequins are not copyrightable. As a result of this practice he has been sued repeatedly for copyright infringement. At the same time that he was making the contention that animal mannequins are not copyrightable, however, he was applying for copyrights for his own mannequins, affixing copyright notices to them, and warning others that his mannequins are "legally copyrighted" and "any infringement will be vigorously prosecuted." When one of his fish mannequins was found by a court to be not copyrightable — a decision that he now argues vindicates his contention that animal mannequins are not copyrightable — he nevertheless continued to warn the public, "Beware of look-a-likes," and "[D]esperate 'copy cats' [are] working overtime in an attempt to deceive the public and violate the rights of others." (Emphasis added). Moreover, he continued to attach copyright notices to his mannequins to

"bluff" others into believing his forms were copyrighted. He admits that he is a member of a trade association that has adopted an ethical code that prohibits copying, but characterizes the code as "whitewash," which was "passed for show."

The district court recognized that it was not required to award attorneys fees to the prevailing party and did so only after carefully considering each of the relevant factors. In this case, it found Chase's conduct "outrageous," and we conclude that the court's finding is amply supported. Under such circumstances, we do not find the district court's award in this case to constitute an abuse of discretion.

For the foregoing reasons, the judgment of the district court is

AFFIRMED.

**U.S. Court of Appeals
Federal Circuit**

In re Alton

No. 94-1495

Decided February 5, 1996

PATENTS

1. Practice and procedure in Patent and Trademark Office — Prosecution — Declaration/Affidavits (§110.0913)

Patentability/Validity — Specification — Written description (§115.1103)

Patent examiner erred by viewing declaration of person skilled in art as opinion evidence addressing question of law rather than question of fact, since declaration attempted to shed light on question of whether specification adequately described subject matter of application claim, since that question is one of fact, and since declaration, rather than asserting opinion on patentability of claimed human gamma interferon analog, offers factual evidence in attempt to explain why one of ordinary skill would have understood specification to describe particular analog claimed.

2. Practice and procedure in Patent and Trademark Office — Prosecution — Declaration/Affidavits (§110.0913)

Patentability/Validity — Specification — Written description (§115.1103)

Patent examiner erred by dismissal of person skilled in art with inadequate explanation of how declaration to overcome prima facie case for rejection ground that application did not provide adequate written description of subject in claim for human gamma interferon analog, since statement in examiner's that specification encompasses sufficient number of possible analogs does not thrust of declaration, which explained one of ordinary skill in art would have realized that applicants had possession of particular analog on their claim's date.

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of Norman K. Mary A. Peters, Yitzhak Tabinski, et al., L. Snitman, serial no. 06/483,451, April 15, 1983, which is continuation of application filed May 6, 1983, not done. From decision upholding examination of application claim 70 for failure to comply with written description requirement of 35 USC 112, applicants vacated and remanded.

Michael F. Borun, of Marshall, Gerstein, Murray & Borun, Chicago, and Li-Hsien Rin-Laures, Chicago, et al., v. M. Ode, Thousand Oaks, California, et al., and Ron K. Levy, Thousand Oaks, for appellants.

Scott A. Chambers, associate solicitor; J. Link, solicitor; Albin F. Drosky, solicitor, and Richard Torczon, associate solicitor, Arlington, Va., for appellees. Before Michel, circuit judge, Friedman, circuit judge, and Schall, circuit judge, and Schall, J.

Appellants Norman K. Alton, et al., ("Alton"), appeal the ruling of the United States Patent and Trademark Office Board of Patent Appeals and Interferences ("Board of Appeals") in its decision (Appeal No. 94-3098). In its decision the Board held that the specification of the application (serial number 06/483,451 ("Application")) did not provide adequate descriptive support for the amino acid sequence of human gamma interferon ("IFN-γ") described in claim 70. W

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2. Practice and procedure in Patent and Trademark Office — Prosecution — Declaration/Affidavits (§110.0913)

Patentability/Validity — Specification — Written description (§115.1103)

Patent examiner erred by dismissing declaration of person skilled in art without adequate explanation of how declaration failed to overcome prima facie case for rejection on ground that application did not provide adequate written description of subject matter in claim for human gamma interferon analog, since statement in examiner's answer that specification encompasses substantial number of possible analogs does not refute thrust of declaration, which explains why one of ordinary skill in art would have realized that applicants had possession of one particular analog on their claimed filing date.

Appeal from the U.S. Patent and Trade- mark Office, Board of Patent Appeals and Interferences.

Patent application of Norman K. Alton, Mary A. Peters, Yitzhak Tabinski, and David L. Snitman, serial no. 06/483,451, filed April 15, 1983, which is continuation-in-part of application filed May 6, 1983, now abandoned. From decision upholding examiner's rejection of application claim 70 for failure to comply with written description requirement of 35 USC 112, applicants appeal. Vacated and remanded.

Michael F. Borun, of Marshall, O'Toole, Gerstein, Murray & Borun, Chicago, Ill.; Li-Hsien Rin-Laures, Chicago, and Steven M. Odre, Thousand Oaks, Calif.; Robert R. Cook and Ron K. Levy, Thousand Oaks, for appellants.

Scott A. Chambers, associate solicitor; Nancy J. Link, solicitor; Albin F. Drost, deputy solicitor, and Richard Torczon, associate solicitor, Arlington, Va., for appellee. Before Michel, circuit judge, Friedman, senior circuit judge, and Schall, circuit judge. Schall, J.

Appellants Norman K. Alton, et al. ("Alton"), appeal the ruling of the United States Patent and Trademark Office Board of Patent Appeals and Interferences ("Board") in Appeal No. 94-3098. In its decision, the Board held that the specification of application serial number 06/483,451 ("the '451 application") did not provide adequate written descriptive support for the amino acid sequence of human gamma interferon ("IFN-γ") described in claim 70. We vacate

the decision and remand the case to the Board for further proceedings.

BACKGROUND I.

IFN-γ is a protein secreted by cells in the human immune system to stimulate immunological activity.¹ Patrick W. Gray et al., *Expression of Human Immune Interferon cDNA in E. Coli and Monkey Cells*, 295 Nature 503 (1982). IFN-γ is believed useful because it activates macrophages, which are a class of cells in the immune system. Bruce Alberts et al., *Molecular Biology of the Cell* 1048, 1049 (2d ed. 1989). IFN-γ is composed of a sequence of 146 amino acids.² The complete sequence is divided into four subunits. IFN-γ polypeptides containing alterations in the naturally-occurring amino acid sequence are called "analogs."

Claim 70 of the '451 application, set forth below, recites an analog of IFN-γ:

[Met¹, des-Cys¹, des-tyr², des-cys³]

IFN-γ polypeptide produced by a DNA sequence coding therefor in a transformant organism, said product having substantially the characteristics of human immune interferon.

(brackets in original). The bracketed words at the beginning of the claim indicate how the claimed IFN-γ differs from the natural version of IFN-γ.³ "Met," "cys," and "tyr" are abbreviations for three of the twenty amino acids; they stand for methionine, cysteine, and tyrosine, respectively. A positive superscripted number following the abbreviation of an amino acid indicates the position of that amino acid in the 146 amino acid chain that comprises IFN-γ. For example, "tyr²" means that tyrosine is the second amino acid in the 146 amino acid chain. The designation "des" preceding the name of the amino acid indicates that that particular amino acid has been deleted and no amino acid has been substituted in its place. Therefore, "[des-cys¹, des-tyr², des-cys³]" means that the cysteine at position one of the amino acid chain has been removed, as has the

¹ We understand the parties to be in agreement on the facts regarding the technology in this case.

² Amino acids, of which there are twenty, are small organic molecules. Benjamin Lewin, *Genes* V 11 (1994). Amino acids combine in linear chains to form proteins. *Id.* at 14. A protein is sometimes referred to as a polypeptide.

³ The 146-amino acid sequence of the IFN-γ analog recited in claim 70 is attached to this opinion.

tyrosine at position two and the cysteine at position three. A negative superscripted number indicates that an amino acid has been added onto the beginning (the N-terminus) of the IFN- γ sequence. Thus, "met-¹" means that a methionine has been placed at the beginning of the IFN- γ amino acid chain.

In sum, the analog of IFN- γ recited in claim 70 has two characteristics that distinguish it from the natural version of IFN- γ . First, as "[des-cys¹, des-tyr², des-cys³]" indicates, the first three amino acids — cysteine, tyrosine, and cysteine — of the natural 146 amino acid sequence have been deleted from the claimed IFN- γ analog. These three amino acids are located on the fourth subunit ("IF-4") of the complete sequence. Second, methionine has been placed at the beginning of the amino acid sequence of the claimed analog.

The '451 application's specification contains twelve examples of IFN- γ analogs. Of these, Example 5 is closest to the analog that is the subject of claim 70. Like claim 70, it discloses deletion of the first three amino acids and placement of methionine at the beginning of the amino acid sequence of IFN- γ ("[met-¹, des-cys¹, des-tyr², des-cys³]"). Unlike claim 70, however, Example 5 additionally discloses substitution of asparagine — the eighty-first amino acid in the IFN- γ chain — with lysine, another amino acid ("lys⁸¹"). The eighty-first amino acid is located on the second subunit ("IF-2") of the IFN- γ sequence.

II.

The '451 application was filed April 15, 1983. It is a continuation-in-part of a parent application filed on May 6, 1982, and later abandoned. The examiner issued a final rejection of the claims of the '451 application as anticipated under 35 U.S.C. § 102(e) and rendered obvious over the prior art under 35 U.S.C. § 103.

Alton appealed the examiner's final rejection to the Board. On February 28, 1991, the Board reversed the examiner's section 102 and 103 rejections but rejected the claims on the new ground that the specification failed to describe adequately the subject matter of the claims, as required by 35 U.S.C. § 112, § 1. The Board stated: "The closest analog to that claimed herein is described [in Example 5]. This particular analog, though similar to that claimed herein, does not constitute a description of the claimed analog."

Electing further prosecution pursuant to 37 C.F.R. 1.196(b),⁴ Alton submitted to the

examiner, in response to the Board's section 112, § 1 rejection, a declaration by Dr. Randolph Wall (the "Wall declaration"). In due course, the examiner issued a final rejection on the same grounds as had the Board. Alton then requested reconsideration; the examiner denied the request and maintained his rejection ("final rejection").

Alton appealed the final rejection of claim 70 to the Board. The examiner filed his Answer and the Board sustained the section 112, § 1 rejection on June 21, 1994. In its decision, the Board held that "the specific polypeptide of claim 70 was not described in the original specification of application Serial No. 06/483,451." The Board adopted the examiner's dismissal of the Wall declaration, in which the examiner reasoned that the declaration was opinion evidence rather than factual evidence. The examiner stated, "Little weight is given an opinion affidavit on the ultimate legal question at issue." This appeal followed.

DISCUSSION

I.

The issue of whether a patent specification adequately describes the subject matter claimed is a question of fact. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). We review questions of fact arising from Board rejections under a clearly erroneous standard. *In re Caveney*, 761 F.2d 671, 674, 225 USPQ 1, 3 (Fed. Cir. 1985). We review questions of law *de novo*. *Electronic Design & Sales, Inc., v. Electronic Data Systems Corp.*, 954 F.2d 713, 715, 21 USPQ2d 1388, 1390 (Fed. Cir. 1992).

II.

Alton contends that the Board committed clear error in holding that the '451 specification did not describe the subject matter of

When the Board of Patent Appeals and Interferences makes a new rejection of an appealed claim, the appellant may ... submit ... a showing of facts ... and have the matter reconsidered by the examiner in which event the application will be remanded to the examiner. The statement shall be binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground for rejection stated in the decision. Should the examiner again reject the application the applicant may again appeal to the Board of Patent Appeals and Interferences.

claim 70. Alton additionally argues Board erred in failing to give substantial weight to the Wall declaration.

The adequate written description requirement of 35 U.S.C. § 112, § 1, provides "[t]he specification shall contain a description of the invention, in manner and process of making, a use, or in such full, clear, concise, and terse terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." (emphasis added).

The adequate written description requirement, which is distinct from the enablement and best mode requirements,⁵ seeks to ensure that the inventor had possession of the specific subject matter later claimed; how the specification accomplishes this is not material." *In re Wertheim*, 552 F.2d 257, 262, 191 USPQ2d 90, 96 (CCPA 1977). In order to meet the adequate written description requirement, the applicant must have to utilize any particular form or manner to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). Put another way, "the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date or the priority date, if applicable, he or she was in possession of the claimed invention." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1561, 19 USPQ2d at 1117. Finally, we have held that "[p]recisely how close the original description must come to comply with the written description requirement of section 112 is determined on a case-by-case basis." *Stein v. Frank*, 52 F.3d 1035, 1038, 1 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1561, 19 USPQ2d at 1116).

⁵ In order to be considered enabling, the specification must give persons of ordinary skill in the art enough information to practice the invention without undue experimentation. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1575, 19 USPQ2d 409, 413 (Fed. Cir. 1984). The enablement requirement mandates that the inventor disclose the best mode known to him or her at the time the patent application is filed. *Spectra, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1528, 1 USPQ2d 1737, 1745 (Fed. Cir.), cert. denied, 484 U.S. 954 (1987).

⁴ 37 C.F.R. § 1.196(b) (1994) states:

onse to the Board's section a declaration by Dr. Ran-Wall declaration"). In due ner issued a final rejection ds as had the Board. Alton consideration; the examin-quest and maintained his rejection").

the final rejection of claim l. The examiner filed his Board sustained the section n on June 21, 1994. In its ard held that "the specific im 70 was not described in ification of application Ser-51." The Board adopted the ssal of the Wall declaration, aminer reasoned that the opinion evidence rather than The examiner stated, "Lit-n an opinion affidavit on the estion at issue." This appeal

DISCUSSION

I.

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II.

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rd of Patent Appeals and Inter-s a new rejection of an appealed ellant may ... submit ... a s.... and have the matter recon- examiner in which event the l be remanded to the examiner. shall be binding upon the exam-amendment or showing of facts of record be made which, in the examiner, overcomes the new jection stated in the decision. aminer again reject the applica-cant may again appeal to the nt Appeals and Interferences.

claim 70. Alton additionally argues that the Board erred in failing to give substantial weight to the Wall declaration.

The adequate written description require-ment of 35 U.S.C. § 112, ¶ 1, provides that [t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(emphasis added).

The adequate written description require-ment, which is distinct from the enablement and best mode requirements,⁵ serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the adequate written description requirement, the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citation omitted). Put another way, "the applicant must ... convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Vas-Cath*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. Finally, we have stated that "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." *Eiselsstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting *Vas-Cath*, 935 F.2d at 1561, 19 USPQ2d at 1116).

⁵ In order to be considered enabling, a patent must give persons of ordinary skill in the relevant art enough information to practice the invention disclosed in the specification without undue experimentation. *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984). The best mode requirement mandates that the inventor disclose the best mode known to him or her at the time the patent application is filed. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1535, 3 USPQ2d 1737, 1745 (Fed. Cir.), cert. denied, 484 U.S. 954 (1987).

As noted above, following the Board's decision of February 28, 1991, Alton elected further prosecution pursuant to 37 C.F.R. § 1.196(b). In that context, Alton submitted the Wall declaration in response to the Board's section 112, ¶ 1 rejection. In paragraph 9J of his declaration, Dr. Wall addressed the issue of whether Example 5 in the specification described what was claimed in claim 70:⁶

J. The specific modifications of subunit IF-4 for deleting both cysteines and the intermediate tyrosine at amino acid positions 1, 2, and 3 are set out at page 50, lines 11 and 12, which describe modification of the IF-4 subunit (which contains a methionyl residue-specifying codon at position -1) to contain the codons,

5'-ATG CAG-3'
3'-TAC GTC-5'

in the amino acid specifying region. ATG is a codon specifying methionine; CAG is a codon specifying glutamine. Expression of a complete, four subunit, DNA sequence with this modification in subunit IF-4 operatively provides a polypeptide of claims 70. . . . It is my opinion that a skilled worker in molecular biology and the cloning and expression of genes, would, in 1983, have understood the proposed modification [des-cys¹, des-tyr², des-cys³] to have been described independently of any suggestion to alter the arginine [sic: asparagine⁷] residue at position 81 of mature human immune interferon. While the specific analog including both the changes in the mature human immune interferon was described as being made and tested, that compound was noted to be an "example" of polypeptide analogs wherein cysteines were deleted for the purpose of facilitating isolation of analogs by destroying the possibility of intermolecular disulfide bridge⁸ formation. Modifying the residue at position 81 would have no effect on this property because neither arginine [sic: asparagine] nor lysine can

⁶ The parties do not dispute that Dr. Wall has the requisite skill in the art.

⁷ We understand the parties to be in agreement that recitation in the Wall declaration of the amino acid "arginine," instead of "asparagine," was a typographical error.

⁸ Cysteines contain a sulfur atom. The sulfur atom of a cysteine in an amino acid chain can bond to the sulfur atom in a second cysteine at another location in the same amino acid sequence. Benjamin Lewin, *Genes V* 14 (1994). The resulting cysteine-cysteine bond, known as a disulfide bridge, causes the amino acid chain to bend back on itself. *Id.*

participate in disulfide bridge formation. Moreover, changing to [sic] residue at position 81 would involve a modification in subunit IF-2, requiring an entirely separate series of manipulations of the complete DNA sequence to generate this different class of analog.

Among other things, the Wall declaration states that one of ordinary skill in the art in 1983 would have known, first, that a problem involved with isolating analogs was the incapacity of the amino acid sequence to form bonds with itself through disulfide bridges, and second, that deletion of cysteines would eliminate this phenomenon. According to Dr. Wall, one of ordinary skill in the art would have understood the discussion in the specification of Example 5 to be offered as an illustration of the deletion of cysteines. Therefore, according to Dr. Wall, one of ordinary skill in the art, knowing that deleting the first three amino acids of the complete sequence would affect disulfide bridge formation but that the existence of lysine at position 81 would not, would have understood the specification to describe the two modifications independently. Also according to Dr. Wall, a second reason one of ordinary skill in the art would have understood the specification to describe the two modifications independently is that the first three amino acids are located on subunit IF-4, whereas the eighty-first amino acid is located on subunit IF-2.

In his final rejection, which was adopted by the Board, the examiner stated that the specification did not convey that Alton had possession of the subject matter of claim 70 as of April 15, 1983 — the filing date of the '451 application. In support of the rejection, referring to Example 5, the examiner asserted that the only example in the specification that described deletion of the first three amino acids and placement of methionine at the beginning of the amino acid sequence of IFN- γ additionally described substitution of asparagine — the eighty-first amino acid in the IFN- γ chain — with lysine, another amino acid. Turning to the Wall declaration, the examiner stated:

In order to support patentability of the claims Dr. Wall points to the same text of the specification as previously identified by the Board of Patent Appeals and Interferences as being insufficient. Importantly, Dr. Wall arrives at a conclusion which is opposite that determined by the Board. . . . In view of the previous discussion of the Board of Patent Appeals and Inter-

ferences and the evidence of record, this argument is not found to be persuasive. . . .

The weight given to the 132 Declaration by Dr. Wall, in particular paragraph . . . 9J, depends on whether it presents allegations, opinions or facts. In this case the Declaration does not point to inherent support or evidence to support the conclusory statement in paragraph 9J. Little weight is given an opinion affidavit on the ultimate legal question at issue.

In short, the examiner rejected Dr. Wall's opinion that "a skilled worker in molecular biology and the cloning and expression of genes, would, in 1983, have understood the proposed modification to have been described independently of any suggestion to alter the arginine [sic] residue at position 81 of mature human immune interferon." The examiner maintained this position in his Answer. In his Answer, the examiner stated that

the Wall Declaration does not suggest that the written description in the specification supports an interferon-gamma which *must* have the claimed structure. Indeed, the number of possible interferon-gamma analogs encompassed by the written description of the invention is substantial and the specification does not lead to any compound which must have the claimed structure.

As already seen, the Board adopted as its own the examiner's response to Alton's arguments:

We express no opinion on the factual question of whether the specification adequately describes the subject matter of claim 70.⁹ We do, however, hold that the examiner's final rejection and Answer contained two errors: (1) viewing the Wall declaration as opinion evidence addressing a question of law rather than a question of fact; and (2) the summary dismissal of the declaration, without an adequate explanation of why the declaration failed to rebut the Board's prima facie case of inadequate description.

III.

A. The Examiner Erred by Mistaking a Question of Fact for a Question of Law

⁹ See *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993) ("If a conception of a DNA requires a precise definition, such as by structure, formula, chemical name, or physical properties, . . . then a description also requires that degree of specificity.")

As seen above, in his final rejection the examiner stated that the weight given to Dr. Wall's declaration

depends on whether it presents allegations, opinions or facts. In this case the Declaration does not point to inherent support or evidence to support the conclusory statement in paragraph 9J. Little weight is given an opinion affidavit on the ultimate legal question at issue.

In his Answer, the examiner continued

[i]t is apparently the "*opinion*" (added) of Dr. Wall that, as of the filing date of this application, one of ordinary skill in the art would have interpreted . . . the specification as providing specific guidance for the preparation of interferon analogs lacking the cysteine residues at the amino terminus. . . . The weight is given an opinion affidavit on the ultimate legal question at issue. . . . The written description for the invention is not claimed.

[1] It is well settled that the question of whether a specification provides an adequate written description of the subject matter of the claims is an issue of fact. The examiner was in error when he stated that the Wall declaration, which addressed the question of whether the '451 specification adequately described the subject matter of claim 70, addressed a legal issue.

Additionally, the examiner in his Answer stated that the Wall declaration as offering opinion evidence, rather than factual evidence, rendered the adequate written description in the Wall declaration's assertion that "changing the residue at position 81 would have no effect on [disulfide bridge formation] because neither [asparagine] nor [methionine] participate in disulfide bridge formation." a factual statement, however. So stated that changing the amino acid at position 81 would involve a modification in subunit IF-2, "requiring an entirely separate series of manipulations of the [amino acid] sequence to generate a different class of analog." We do not find the declaration as asserting an opinion on the patentability of the claimed IFN- γ . Rather, the declaration is offering opinion evidence in an attempt to explain why one of ordinary skill in the art would have understood the specification to describe a modification involving the deletion of the first three amino acids independently of the modification at position 81. Dr. Wall's use of the words "it is my opinion" rather than "what someone of ordinary skill in the art would have known does not detract from the factual statements contained in the

the evidence of record, this was not found to be persuasive. . . . Given to the 132 Declaration in particular paragraph . . . on whether it presents allegations or facts. In this case the declaration does not point to inherent support to support the conclusory statement in paragraph 9J. Little weight is given an opinion affidavit on the ultimate legal question at issue.

The examiner rejected Dr. Wall's statement that skilled workers in molecular biology and cloning and expression of genes in 1983, have understood the specification to have been dependent on any suggestion to determine [sic] residue at position 81 of an immune interferon. The examiner stated this position in his Answer. In his answer, the examiner stated

the declaration does not suggest that the description in the specification of interferon-gamma which must have a claimed structure. Indeed, the possible interferon-gamma analogs suggested by the written description of the invention is substantial and the declaration does not lead to any conclusion that must have the claimed

structure. When the Board adopted as its decision the examiner's response to Alton's

the examiner's opinion on the factual question of whether the specification adequately described the subject matter of claim 70. The Board, however, held that the examiner's decision and Answer contained two errors: (1) in viewing the Wall declaration as merely addressing a question of fact; and (2) in the dismissal of the declaration, without adequate explanation of why the declaration failed to rebut the Board's prima facie inadequate description.

III.

Examiner Erred by Mistaking a Question of Fact for a Question of Law

Revel, 984 F.2d 1164, 1171, 25 USPQ2d 1606 (Fed. Cir. 1993) ("If a claim for a DNA requires a precise definition by structure, formula, chemical properties, . . . then a description that degree of specificity.")

As seen above, in his final rejection, the examiner stated that the weight given to Dr. Wall's declaration

depends on whether it presents allegations, opinions or facts. In this case the Declaration does not point to inherent support or evidence to support the conclusory statement in paragraph 9J. Little weight is given an opinion affidavit on the ultimate legal question at issue.

In his Answer, the examiner continued that

[i]t is apparently the "opinion" (emphasis added) of Dr. Wall that, as of the filing date of this application, one skilled in the art would have interpreted . . . the specification as specific guidance for a class of interferon analogs lacking the cys-tyr-cys residues at the amino terminus. . . . Little weight is given an opinion affidavit on the ultimate legal question at issue regarding the written description for the invention now claimed.

[1] It is well settled that the question of whether a specification provides an adequate written description of the subject matter of the claims is an issue of fact. Therefore, the examiner was in error when he stated that the Wall declaration, which attempted to shed light on whether the '451 specification adequately described the subject matter of claim 70, addressed a legal issue.

Additionally, the examiner interpreted the Wall declaration as offering opinion evidence, rather than factual evidence, on the adequate written description issue. The Wall declaration's assertion that "[m]odifying the residue at position 81 would have no effect on [disulfide bridge formation] because neither [asparagine] nor lysine can participate in disulfide bridge formation" is a factual statement, however. So too is the statement that changing the amino acid at position 81 would involve a modification in subunit IF-2, "requiring an entirely separate series of manipulations of the complete [amino acid] sequence to generate this different class of analog." We do not read the declaration as asserting an opinion on the patentability of the claimed IFN- γ analog. Rather, the declaration is offering factual evidence in an attempt to explain why one of ordinary skill in the art would have understood the specification to describe the modification involving the deletion of the first three amino acids independently of the modification at position 81. Dr. Wall's use of the words "it is my opinion" to preface what someone of ordinary skill in the art would have known does not transform the factual statements contained in the declara-

tion into opinion testimony.¹⁰ Consequently, the examiner's dismissal of the declaration on the grounds that "[l]ittle weight is given an opinion affidavit on the ultimate legal question at issue" was error.

B. The Examiner Erred by Failing to Articulate Adequate Support for the Rejection

The examiner also erred by dismissing the Wall declaration without an adequate explanation of how the declaration failed to overcome the prima facie case initially established by the Board — the rejection on the ground that the application failed to describe the subject matter of claim 70. The examiner (or the Board, if the Board is the first body to raise a particular ground for rejection) "bears the initial burden . . . of presenting a prima facie case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Insofar as the written description requirement is concerned, that burden is discharged by "presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. Thus, the burden placed on the examiner varies, depending upon what the applicant claims. If the applicant claims embodiments of the invention that are completely outside the scope of the specification, then the examiner or Board need only establish this fact to make out a prima facie case. *Id.* at 263-64, 191 USPQ at 97. If, on the other hand, the specification contains a description of the claimed invention, albeit not *in ipso verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. *Id.* at 264, 191 USPQ at 98. Once the examiner or Board carries the burden of making out a prima facie case of unpatentability, "the burden of coming forward with evidence or argument shifts to the applicant." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. To overcome a prima facie case, an applicant must show that the invention as claimed is adequately described to

¹⁰ In any event, we are aware of no reason why opinion evidence relating to a fact issue should not be considered by an examiner. See *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294, 227 USPQ 657, 665 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986).

ne skilled in the art. "After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of the evidence with due consideration to persuasiveness of argument." *Id.* at 1445, 24 USPQ2d at 1444.

After claim 70 was first rejected on section 112, ¶ 1 grounds, Alton submitted evidence to rebut the rejection in the form of the Wall declaration.¹¹ The Wall declaration contained statements of fact directly addressing the issue of whether the specification adequately described the subject matter recited in claim 70. The purpose of the adequate written description requirement is to ensure that the inventor had possession of the claimed subject matter at the time the application was filed. If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met. For example, in *Ralston Purina Co. v. Far-Mar Co., Inc.*, 772 F.2d 1570, 1576, 227 USPQ 177, 180 (Fed. Cir. 1985), the trial court admitted expert testimony about known industry standards regarding temperature and pressure in "the art of extrusion of both farinaceous and proteinaceous vegetable materials." The effect of the testimony was to expand the breadth of the actual written description since it was apparent that the inventor possessed such knowledge of industry standards of temperature and pressure at the time the original application was filed. Similarly, the Wall declaration in essence attempts to expand the breadth of the specification by arguing that a person of ordinary skill in the art would have understood the two modifications in Example 5 of the specification to be described independently of each other and thus a description of both modifications would include a description of either separately.

The thrust of the examiner's response to the Wall declaration, in both the final rejection and the Answer, is that the specification must describe the precise analog claimed. This explains why the examiner stated that the Wall declaration was inadequate because it did not "suggest that the written description in the specification supports an

interferon-gamma analog which *must* have the claimed structure." This argument, however, does not address the point that paragraph 9J of the Wall declaration attempts to make: that one of ordinary skill in the art would have understood the specification to describe the two modifications ([met⁻¹, des-cys¹, des-tyr², des-cys³] and lys¹¹) independently and that the description of both modifications together would be relevant as an example of only one of those modifications ([met⁻¹, des-cys¹, des-tyr², des-cys³]). Thus, according to the Wall declaration, the specification would be understood to describe the relevant modification ([met⁻¹, des-cys¹, des-tyr², des-cys³]) without the irrelevant one (lys¹¹). Therefore, according to the Wall declaration, one of ordinary skill in the art would understand Alton to be in possession, in 1983, of the claimed subject matter, which contained the [met⁻¹, des-cys¹, des-tyr², des-cys³] modification but not the modification at position 81.

[2] The Wall declaration addresses why the claimed subject matter, although not identical to the analog described in the specification, was in Alton's possession. The statement in the examiner's answer that the number of possible analogs encompassed by the specification is substantial does not rebut the thrust of the Wall declaration because the Wall declaration explains why one of ordinary skill in the art would have realized that Alton had possession of one particular analog. In sum, in his final rejection and again in his Answer, the examiner dismissed the Wall declaration and provided only conclusory statements as to why the declaration did not show that a person skilled in the art would realize that Alton had possession of the claimed subject matter in 1983.

CONCLUSION

First, by concluding that the Wall declaration addressed an issue of law instead of an issue of fact, and second, by failing to articulate adequate reasons to rebut the Wall declaration, the examiner and Board failed to consider the totality of the record for the purpose of issuing a final rejection and thus erred as a matter of law. We are not in a position, however, to determine whether the specification contained an adequate written description of the claimed IFN- γ sequence. That determination requires, in the first instance, further proceedings in which the Wall declaration is addressed in a manner that is consistent with this opinion. The case is remanded to the Board for such further proceedings. *See In*

¹¹ We are satisfied that the Board met its prima facie case of establishing lack of adequate written description in its February 28, 1991 decision by discussing Example 5 of the specification, in which both modifications appeared together.

re Beaver, 893 F.2d 329, 13 USPQ2d 1001 (Fed. Cir. 1989) (vacating Board decision for failing to review all the appeals in accordance with the regulations).

1
Cyr- Tyr- Cys- Gln- Asp-
TGT TAC TGC CAG CAG

Lys- Lys- Tyr- Phe- Asn-
AAG AAA TAT TTT AAT

30
Gly- Thr- Leu- Phe- Leu-
GGA ACT CTT TTC TTA

Ser- Asp- Arg- Lys- Ile-
AGT GAC AGA AAA ATA

60
Phe- Lys- Leu- Phe- Lys-
TTC AAA CTT TTT AAA

Lys- Ser- Val- Glu- Thr-
AAG AGT GTG GAG ACC

Phe- Asn- Ser- Asn- Lys-
TTC AAT AGC AAC AAA

100
Thr- Asn- Tyr- Ser- Val-
ACT AAT TAT TCG GTA

Ile- His- Glu- Leu- Ile-
ATA CAT GAA CTC CTC

130
Ala- Lys- Thr- Gly- Lys-
GCT AAA ACA GGG AAG

U.S. Court of Appeals Sixth Circuit

Rolex Watch U.S.A Inc. v. Cr

Nos. 94-6459/6460

Decided February 2, 1995

JUDICIAL PRACTICE PROCEDURE

1. Procedure — Contempt;
(\$410.49)

REMEDIES

Non-monetary and injunctive —
relief — Permanent injun

declaration addresses why the matter, although not as fully described in the specification, is the subject of the invention. The statement of the answer that the numerical values encompassed by the claim declaration does not rebut the claim declaration because the explanation explains why one of ordinary skill would have realized that the claim declaration was a final rejection and again in the examination dismissed the Wall. The declaration provided only conclusory statements by the declaration did not show one skilled in the art would not have had possession of the invention in 1983.

ding that the Wall declaration is an issue of law instead of fact; and second, by failing to present reasons to rebut the examiner and Board's finding that the totality of the record supported the final rejection. The Board's decision is a matter of law. We are not required, however, to determine whether the specification contained an adequate description of the claimed invention. That determination requires, in this instance, further proceedings. The Board's Wall declaration is affirmed insofar as it is consistent with the evidence in this case and is remanded to the Board for further proceedings. *See In re*

ATTACHMENT A

| | | | | | | | | | | | | | | | |
|------|------|------|------|------|------|------|------|------|------|------|------|------|------|------|------|
| 1 | Cyr- | Tyr- | Cys- | Gln- | Asp- | Pro- | Tyr- | Val- | Lys- | 10 | Glu- | Ala- | Glu- | Asn- | Leu- |
| TGT | TAC | TGC | CAG | CAG | CAA | TAT | GTA | AAA | GAA | GCA | GAA | AAC | CTT | | |
| | | | | 20 | | | | | | | | | | | |
| Lys- | Lys- | Tyr- | Phe- | Asn- | Ala- | Gly- | Bis- | Ser- | Asp- | Val- | Ala- | Asp- | Asn- | | |
| AAG | AAA | TAT | TTT | AAT | GCA | GGT | CAT | TCA | GAT | GTA | GCG | GAT | AAT | | |
| | | | | | | | | | | | | | | | |
| | 30 | | | | | | | | | 40 | | | | | |
| Gly- | Thr- | Leu- | Phe- | Leu- | Gly- | Ile- | Leu- | Lys- | Asn- | Trp- | Lys- | Glu- | Glu- | | |
| GGA | ACT | CTT | TTT | TTA | GGC | ATT | TTG | AAG | AAT | TGG | AAA | GAG | GAG | | |
| | | | | | | | | | | | | | | | |
| | | | | | 50 | | | | | | | | | | |
| Ser- | Asp- | Arg- | Lys- | Ile- | Met- | Gln- | Ser- | Gln- | Ile- | Val- | Ser- | Phe- | Tyr- | | |
| AGT | GAC | AGA | AAA | ATA | ATG | CAG | AGC | CAA | ATT | GTC | TCC | TTT | TAC | | |
| | | | | | | | | | | | | | | | |
| | | | | 60 | | | | | | | | | | 70 | |
| Phe- | Lys- | Leu- | Phe- | Lys- | Asn- | Phe- | Lys- | Asp- | Asp- | Gln- | Ser- | Ile- | Gln- | | |
| TTC | AAA | CTT | TTT | AAA | AAC | TTT | AAA | GAT | GAC | CAG | AGC | ATC | CAA | | |
| | | | | | | | | | | | | | | | |
| | | | | | | | | 80 | | | | | | | |
| Lys- | Ser- | Val- | Glu- | Thr- | Ile- | Lys- | Glu- | Asp- | Met- | Asn- | Val- | Lys- | Phe- | | |
| AAG | AGT | GTG | GAG | ACC | ATC | AAG | GAA | GAC | ATG | AAT | GTC | AAG | TTT | | |
| | | | | | | | | | | | | | | | |
| | | | | | 90 | | | | | | | | | | |
| Phe- | Asn- | Ser- | Asn- | Lys- | Lys- | Lys- | Arg- | Asp- | Asp- | Phe- | Glu- | Lys- | Leu- | | |
| TTC | AAT | AGC | AAC | AAA | AAG | AAA | CGA | GAT | GAC | TTC | GAA | AAG | CTG | | |
| | | | | | | | | | | | | | | | |
| | 100 | | | | | | | | | 110 | | | | | |
| Thr- | Asn- | Tyr- | Ser- | Val- | Thr- | Asp- | Leu- | Asn- | Val- | Gln- | Arg- | Lys- | Ala- | | |
| ACT | AAT | TAT | TCG | GTA | ACT | GAC | TTG | AAT | GTC | CAA | CGC | AAA | GCA | | |
| | | | | | | | | | | | | | | | |
| | | | | | | | 120 | | | | | | | | |
| Ile- | His- | Glu- | Leu- | Ile- | Gln- | Val- | Met- | Ala- | Glu- | Leu- | Ser- | Pro- | Ala- | | |
| ATA | CAT | GAA | CTC | CTC | ATC | CAA | ATG | GCT | GAA | CTG | TCG | CAA | GCA | | |
| | | | | | | | | | | | | | | | |
| | | | | 130 | | | | | | | | | | 140 | |
| Ala- | Lys- | Thr- | Gly- | Lys- | Arg- | Lys- | Arg- | Ser- | Gln- | Met- | Leu- | Phe- | Gln- | | |
| GCT | AAA | ACA | GGG | AAG | CGA | AAA | AGG | AGT | CAG | ATG | CTG | TTT | CAA | | |

Federal district court did not err by finding incredible defendant's assertion that she exercised no dominion or control over jewelry store found to have violated terms of permanent injunction restricting defendant's use of "Rolex" trademarks, and thus cannot be personally held in contempt, since defendant agreed to comply with injunction after date on which her control over jewelry store purportedly ended, since injunction is intended to follow defendant wherever she goes, since defendant is obligated to abide by terms of settlement agreement with regard to jewelry store at all times, and since injunction is legal obligation defendant assumed equally with her codefendant husband.